

**REMARKS/ARGUMENTS**

Claims 1, 2, 11-18, 20-23, 26-28, 31, 32, 35, 45-49, 69, 71, 73, 74, 76, 79-85, 97-101, and 107 were examined. The claims have been amended or cancelled as noted above. Re-examination and reconsideration of the claims, as amended, is respectfully requested.

Dependent claims 11, 49, and 101 were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The objection to dependent claim 11 has been overcome by amending claim 11 to recite that the lumen in the tubular body is "in addition to the guidewire lumen." Applicants have cancelled claims 49 and 101 and therefore respectfully request that the objections to these claims be withdrawn.

Claims 1, 2, 11-18, 20-23, 26-28, 31, 32, 35, 45-49, 69, 71, 73, 74, 76, 79-85, 97-101, and 107 were rejected under 35 U.S.C. 112, first paragraph for lack of enablement. The Examiner asserts that the specification "does not reasonably provide enablement for a groove on the balloon structure sleeve of the embodiment in Figure 5A." (Office Action of March 23, 2006 at page 2.) Such rejections are overcome as follows.

A claimed invention must be enabled "so that any person skilled in the art can make and use the invention without undue experimentation." MPEP 2164.01.

To expedite prosecution of the application and more clearly define the placement of the groove, Applicants have amended independent claims 1 and 2 to recite "an axial groove along at least a portion of the shaft." The specification fully enables this axial groove in ¶22.

For this reason, Applicants believe that the rejection of claim 1 and 2 has been overcome. As claims 11-18, 20-23, 26-28, 31, 32, 35, 45-49, 69, 71, 73, 74, 76, 79-85, 97-101, and 107 depend from claims 1 and 2, Applicants believe that these claims are in condition for allowance.

Claims 1, 2, 11-18, 20-23, 26-28, 31, 32, 35, 45-49, 69, 71, 73, 74, 76, 79-85, 97-101, and 107 were rejected under 35 U.S.C. 112, second paragraph as being indefinite. The

Examiner asserts that claiming an "axial groove along at least a portion of a structure and a passage" is contradictory "since the passage is part of the structure." (Office Action at page 3.)

Applicants' amendments to independent claims 1 and 2, discussed above, render this rejection moot. Applicants believe that claims 1 and 2, as well as claims 11-18, 20-23, 26-28, 31, 32, 35, 45-49, 69, 71, 73, 74, 76, 79-85, 97-101, and 107 depending thereon, are in condition for allowance.

Claims 1, 2, 11-18, 20-23, 26-28, 31, 32, 35, 45-49, 69, 71, 73, 76, 79-85, 97-101, and 107 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,578,009 to Kraus et al. (hereinafter Kraus) in view of U.S. Patent No. 5,613,946 to McKeever. The Examiner asserts that Kraus teaches all elements of the claims except for a catheter body and that McKeever cures this deficiency by teaching a "balloon catheter removably attached to another catheter." (Office Action at page 4.) Applicants respectfully traverse such rejections.

To establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations," MPEP 2143. The Examiner fails to establish a *prima facie* case of obviousness because Kraus and McKeever in combination do not teach or suggest all of the recited elements.

Kraus does not disclose an axial groove extending along at least a portion of the shaft and the passage of a balloon structure as amended in independent claims 1 and 2. In contrast, Kraus teaches that slit 37 (characterized by the Examiner as an axial groove) extends along passage 36 of push rod 34 and the bumper 33. (Kraus at col. 4, lines 32-36) where the push rod 34 and bumper 33 are entirely separate from balloon structure 31 (Kraus at col. 3, lines 23-28; col. 4, lines 12-14; Figures 1A and 3). Furthermore, Kraus does not remotely teach extending slit 37 along passage 41 within balloon structure 31. Neither is there a suggestion or motivation from Kraus or McKeever to do the same, for extending slit 37 would render the invention inoperable as the balloon would not be able to inflate. Clearly slit 37 is not equivalent to an axial groove that extends along a portion of the sleeve passage. Nor does Kraus teach or suggest an axial groove which receives a catheter body as recited in claims 1 and 2. Instead, Kraus teaches that slit 37 simply permits a guidewire to be inserted into or removed from passage 36 (Kraus at col. 4, lines 27-29).

To expedite prosecution, Applicants have further amended claim 1 to recite that the shaft of the balloon structure has a balloon inflation lumen. This is directly contrary to Kraus where the inflation line 32 is separate from the push rod 34 which includes the slit 37.

Thus, even if the guidewire of Kraus is assumed to be a catheter body (as asserted by the Examiner relying on McKeever), the groove would not be in the inflation line 32 of Kraus.

For these reasons, claims 1 and 2 are clearly distinguishable over Kraus in view of McKeever. As claims 11-18, 20-23, 26-28, 31, 32, 35, 45-49, 69, 71, 73, 76, 79-85, 97-101, and 107 depend from claims 1 and 2, Applicants believe that these claims are in condition for allowance.

Claim 74 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kraus in view of McKeever and further in view of U.S. Patent No. 5,395,335 to Jang. As discussed above, independent claims 1 and 2 are clearly distinguishable over Kraus in view of McKeever and hence are in condition for allowance. As claim 74 depends upon claims 1 and 2, Applicants believe that this claim is in condition for allowance.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

James M. Heslin  
Reg. No. 29,541

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 650-326-2400  
Fax: 415-576-0300  
Attachments  
JMH:wys/jke  
60825450 vt